

Serial No. 09/961,205

Page 2

REMARKS/ARGUMENTS

Grouping of Claims

Claims 25-27 comprise a first group, Claim 28 comprises a second group, and Claims 29-30 comprise a third group. The three groups do not stand and fall together.

Claim Rejections under 35 USC §102 and 103

On page 2 of the Final Office Action, the Examiner rejected Claims 25-29 as being anticipated by Long III et al. On page 4 of the Final Office Action, Claim 30 was rejected under 35 USC §103, as being unpatentable over Long III et al. and Yano et al. The Examiner stated on page 2 of the Final Office Action that Long III et al. describes its system as an "operating system varying the starting force and prime pulse (battery pulse) according to the engine coolant temperature and battery state-of-charge." The Examiner cited column 9, lines 18-26 of Long III et al. Column 9, lines 18-28 of Long III et al. state that the "Computer 406 receives engine sensor inputs 408 (e.g., manifold absolute pressure, engine crankshaft 152 speed, coolant temperature....)" The Examiner has interpreted this paragraph incorrectly. A coolant temperature is a device found in nearly all internal combustion engine controls and is used to monitor the temperature of the cylinder heads and engine block. Long III et al. is completely silent with respect to controlling an electric motor in a hybrid vehicle with respect to engine coolant temperature.

The use of a coolant temperature as a parameter in controlling the output of an electric motor in a hybrid vehicle is novel and nonobvious and introduces synergies in the hybridization of an internal combustion engine and electric motor in a hybrid vehicle. Long III et al. merely states that there is an engine coolant temperature and does not specify how it is used. Any assertion on the use of the engine coolant temperature sensor of Long III et al. by the Examiner is purely speculation and is not supported by the art. A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of the invention to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be

Serial No. 09/961,205

Page 3

understood may prompt one "to fall victim to the insidious effect of hindsight syndrome wherein that which only the invention taught is used against its teacher." *In Re Kotzab*, 217 F.3d 1365. The Examiner has fallen victim to hindsight reconstruction and has also ignored the elements (using an internal combustion engine coolant sensor to control an electric motor in a hybrid vehicle) of the claimed invention and failed to explain how and why the claimed subject matter is rendered unpatentable over the prior art and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied on. Long III et al. does not teach or suggest the invention of Claims 25-30.

If the Examiner relies on personal knowledge that the apparatus of the present invention is obvious, Applicants respectfully request support for this assertion in the form of an affidavit that shall be subject to contradiction or explanation by the affidavits of the Applicants and other persons under 37 CFR 1.104(d)(2).

Conclusion

The entire Final Office Action dated May 21, 2003 has been carefully reviewed, and this response is submitted as being fully responsive thereto. In view of the preceding remarks, Applicants respectfully submit that Claims 25-30 are in condition for allowance and respectfully request such action at the Examiner's earliest convenience. If the Examiner believes that personal contact would be advantageous to the disposition of this case, she is requested to call the undersigned at her earliest convenience.

If for some reason a fee needs to be paid, please charge Deposit Account No. 07-0960 for the fees which may be due.

Respectfully submitted,



Christopher DeVries - Attorney
Reg. No. 44,654
Telephone: 313-665-4969

OFFICIAL

CD:plul

FAX RECEIVED

AUG 19 2003